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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,896	02/13/2001	Dan Kikinis	ISURFTV129	3324
52940	7590	02/24/2006	EXAMINER	
TODD S. PARKHURST HOLLAND & KNIGHT LLP 131 S. DEARBORN STREET 30TH FLOOR CHICAGO, IL 60603			RAMAN, USHA	
			ART UNIT	PAPER NUMBER
			2617	
DATE MAILED: 02/24/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/782,896	<b>Applicant(s)</b> KIKINIS, DAN	
	<b>Examiner</b> Usha Raman	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 2<sup>nd</sup>, 2005 has been entered.

***Response to Arguments***

2. Applicant's arguments filed on December 2<sup>nd</sup>, 2005 have been fully considered but they are not persuasive. Applicant's arguments stating that Rosser "neither teaches nor suggests the use of a user system such as a set top box to identify 2D images within an advertisement based on the image characteristics" have been noted. However, the examiner respectfully disagrees. Rosser discloses the step of "stripping off and interpreting" graphics and/or video insertions from signal, wherein the insertion information is encoded in the video signal (such as in the VBI) and the extraction (stripping off) of the insertion is done based on encoded signal format (i.e. graphics and/or video is extracted from the VBI), and therefore based on the image characteristics. See column 7, lines 46-58 and column 10, lines 15-20. Applicant also argues that, "Rosser neither teaches nor suggests that the 3-D highlighted rendering of the image comprises a portion of the original 2-D image and said 3-D object". The examiner respectfully disagrees. Rosser teaches the step of warping 2-D images for presentation, and

further teaches the step processing video signals for displaying text/images as a VRML object along with the video.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-11, 13-17, and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosser (6,446,261).

In regards to claim 1 and 7, Rosser discloses a method for providing enhanced advertising of a 2-D video broadcast (see column 3, lines 22-25, column 5, lines 25-33, and column 10, lines 36-51), comprising the steps of:

Receiving the 2-D video broadcast from the head end (signal provided by LVIS, see column 7, lines 20-24), including a first advertisement (insertion is advertisements, see column 4, lines 49-54) having a 2-D image (insertion includes graphics, see column 6, lines 56-57);

Identifying ("stripping off"/extracting the graphic from signal, see column 7, lines 46-58) the 2-D image within the first advertisement, wherein the 2-D image is identified (i.e. extracted) solely based on its characteristics (identified based on encoded format/characteristics, see column 10, lines 15-20) and based exclusively at viewer's equipment (set top box 44)

Looking up (profile matcher 96 looks up) a matching 3D object (matching object is text, wherein the text may be a VRML/3D object; see column 10, lines

29-35 and column 11, lines 55-56) in an image library, wherein the library comprises one or more 3D objects; (stored insertions, column 7, lines 55-58) and

Using the matching insertion object to generate an enhanced first advertisement (i.e. warper unit warps the text-video and insertion video thereby creating the "warped insertion video", see column 10, lines 31-42); wherein the enhanced first advertisement has a 3-D highlighted rendering of the image (warped insertion video) instead of the 2-D image (image insertion 90); and further wherein the 3-D highlighted rendering of the image (the warped insertion video) comprises a portion of the original 2-D image (graphic insertion 90), and said 3-D object (VRML text). See column 10, lines 31-42.

In further regards to claims 13 and 19, Rosser's system embodies the methods disclosed in claim 1 in a computer readable medium (i.e. the set top box) having the necessary stored instructions in order to perform the recited steps.

In regards to claims 2, 8, 14, and 20, Rosser discloses that there are one or more images (indicia) within the first advertisement. See column 7, lines 5-14.

In regards to claims 3, 9, 15, and 21, Rosser discloses that the enhanced VRML objects can be stored locally, at the set top box. Note column 4, lines 55-60 and column 7, lines 55-58. Therefore, upon receiving the indicia, the appropriate VRML object is retrieved and inserted into the video. Such retrieval inherently requires a "look up table" for locating the VRML object stored locally in the set top box.

In regards to claims 4, 10, 16, and 22, Rosser discloses that the enhanced, 3-D rendered advertisement can be displayed on a television monitor, a computer monitor and such means. See column 7, lines 24-28.

In regards to claims 5, 11, and 17, Rosser teaches the method of warping images/text into the video, therefore also comprises the step of overlaying the additional data over the image in the 2-D advertisement. Note column 10, lines 31-40.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser (US Pat. 6,446,261).

In regards to claims 6, 12, and 18, Rosser does not teach the method of overlaying specular lighting and shading over the image.

Official notice is taken that it is well known to overlay specular lighting and shading on images to give them natural reflective and shading qualities, making them appear as a realistic 3-D image. As an example, Rosser et al. (US Pat. 5,264,933) further discloses adjusting color, and contrast ratios for giving the inserted image a realistic appearance, as if it were part of the original video. Note column 8, lines 48-column 9, line 24 in Rosser et al.

It would have been obvious to one of ordinary skill in the art to adjust the specular lighting and the shading of the image, in order to give it a more realistic, 3-D appearance.


***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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